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10/806,307

03/22/2004

Gregory A. Stobbs

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07/18/2006

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/806,307 | Applicant(s) STOBBS ET AL. | |
| | Examiner Jean M. Corrielus | Art Unit 2162 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/22/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Application filed on March 22, 2004, in which claims 1-10 are pending for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) filed on October 06, 2004 complies with the provisions of M.P.E.P 609. It has been placed in the application file. The information referred to therein has been considered as to the merits.

Drawings

3. Applicants are required to furnish the formal drawings in response to this office action if ***the formal drawings have not been submitted***. No new matter may be introduced in the required drawings. Failure to timely submit a drawing will result in ABANDONMENT of the application.

Claim Objections

4. Claim 1 is objected to because of the following informalities: claim 1, line 5 after "metric:" please add --and--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 1 recites the limitation "the claim text" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Remark

7. Applicant claimed invention is directed to the use of associating a claim breadth metric with a claim text and stored such associated metric in a computer readable dataset. However, the provisional application number 60/119,210 filed on February 5, 1999, in which the Applicant has claimed priority benefit is not supported the invention as claimed. Therefore, the claimed invention cannot benefit the priority date of the provisional application.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-10 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-7 and 11 of copending Application No. 09/499,238. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: Claim 1 of the instant application substantially recites the limitations of claim 1 of the cited co-pending application. The claim merely omits certain the underlined limitations and replaces the bolded limitations as shown in comparison table 1 below.

| Application Claim 1 | Co-pending Application 1 |
|---|--|
| <p>1. A computer-implemented patent portfolio analysis method comprising: retrieving a corpus of patent information from a database, said patent information including <u>the claim text of at least one claim; analyzing the claim text of said at least one claim to generate a claim breadth metric;</u> associating a claim breadth metric with <u>said claim text</u> and storing said associated claim breadth metric in a computer-readable dataset.</p> | <p>1. A computer-implemented patent portfolio analysis method comprising: retrieving a corpus of patent information from a database, said patent information including multiple claims from a plurality of patent documents; automatically determining claim breadth metrics for the multiple claims; associating a claim breadth metric with a claim and storing said associated claim breadth metric in a computer-readable dataset, wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is.</p> |

Table 1

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claim 1 of the instant US application since the omission and addition of the cited limitations would have not changed the process according to which the process of patent portfolio analysis. Therefore, the ordinary skilled artisan would have been also motivated to modify claim 1 of the cited instant US application by titling the use of having a claim text of at least one claim; analyzing the claim text of said at least one claim to generate a claim breadth metric with the use of having **multiple claims from a plurality of patent documents; automatically determining claim breadth metrics for the multiple claims**, since the cited omitting and adding elements would not interfere with the functionality of the steps previously claimed and would perform the same function.

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The dependent claims 2-7 of the instant application are rejected for fully incorporating the errors of the respective base claims by dependency.

| Application Claims 2- 7 | Co-pending Application 2-7 |
|--|--|
| <p>2. (Original) The method of claim 1 wherein said step of analyzing the claim text includes counting the number of words in said claim text and generating a claim breadth metric therefrom.</p> <p>3. (Original) The method of claim 1 wherein said step of analyzing the claim text includes identifying within said claim text a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said counts to generate said claim breadth metric.</p> <p>4. (Original) The method of claim 1 wherein said step of analyzing the claim text includes parsing said text to identify parts of speech, using said identified pads of speech to identify clauses within said claim, comparing said clauses with the text of other claims in said corpus to generate scores indicative of which clauses within said claim text have a lower probability of being found in other claims within said corpus.</p> <p>5. (Original) The method of claim 1 further comprising displaying said patent information in a sorted order based on said claim breadth metric.</p> <p>6. (Original) The method of claim 1 wherein said step of analyzing the claim text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus.</p> <p>7. (Original) The method of claim 6 further comprising displaying said claim text such that said one clause is visually presented differently than the other of said clauses.</p> | <p>2. (Original) The method of claim 1 wherein said step of analyzing the claim text includes counting the number of words in said claim text and generating a claim breadth metric therefrom.</p> <p>3. (Original) The method of claim 1 wherein said step of analyzing the claim text includes identifying within said claim text a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said counts to generate said claim breadth metric.</p> <p>4. (Original) The method of claim 1 wherein said step of analyzing the claim text includes parsing said text to identify parts of speech, using said identified pads of speech to identify clauses within said claim, comparing said clauses with the text of other claims in said corpus to generate scores indicative of which clauses within said claim text have a lower probability of being found in other claims within said corpus.</p> <p>5. (Original) The method of claim 1 further comprising displaying said patent information in a sorted order based on said claim breadth metric.</p> <p>6. (Original) The method of claim 1 wherein said step of analyzing the claim text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus.</p> <p>7. (Original) The method of claim 6 further comprising displaying said claim text such that said one clause is visually presented differently than the other of said clauses.</p> |

Table 2

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Claim 8 of the instant application substantially recites the limitations of claim 11 of the cited co-pending application. The claim merely omits certain the underlined limitations and replaces the bolded limitations as shown in comparison table 3 below.

| Application Claim 8 | Co-pending Application 11 |
|--|--|
| 8. A computer-implemented patent portfolio analysis method comprising: retrieving a corpus of patent information from a database; <u>analyzing said patent information to generate a category metric;</u> associating said category metric with <u>said patent information</u> and storing said associated metric in a computer-readable dataset. | 11. A computer-implemented patent portfolio analysis method comprising: retrieving a corpus of patent information from a database, said patent information including multiple claims from a plurality of patent documents; automatically determining claim breadth metrics for the multiple claims; associating a claim breadth metric with a claim and storing said associated claim breadth metric in a computer-readable dataset, wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is. |

Table 3

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claim 1 of the instant US application since the omission and addition of the cited limitations would have not changed the process according to which the process of patent portfolio analysis. Therefore, the ordinary skilled artisan would have been also motivated to modify claim 1 of the cited instant US application by substituting the use of analyzing the patent information to generate a category metric with the use of having **multiple claims from a plurality of patent documents; automatically determining claim breadth metrics for the multiple claims**, since the cited omitting and adding elements would not interfere with the functionality of the steps previously claimed and would perform the same function.

The dependent claims 9-10 of the instant application are rejected for fully incorporating the errors of the respective base claims by dependency.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-9 rejected under 35 U.S.C. 102(e) as being anticipated by Barney et al., (hereinafter “Barney”) US Patent no. 6,556,992.

As to claim 1, Barney discloses the claimed “retrieving a corpus of patent information from a database, said patent information including the claim text of at least one claim” (col.11, lines 44-65; col.24, lines 14-18);” analyzing the claim text of said at least one claim to generate a claim breadth metric”(col.24, lines 14-35); and “associating a claim breadth metric with said claim text and storing said associated claim breadth metric in a computer-readable dataset” (col.26, lines 1-56).

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As to claim 2, Barney discloses the claimed wherein said step of analyzing the claim text includes counting the number of words in said claim text and generating a claim breadth metric therefrom (col.20, lines 20-46).

As to claim 3, Barney discloses the claimed wherein said step of analyzing the claim text includes identifying within said claim text a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said counts to generate said claim breadth metric (col.20, lines 35-65).

As to claim 4, Barney discloses the claimed wherein said step of analyzing the claim text includes parsing said text to identify parts of speech, using said identified pads of speech to identify clauses within said claim, comparing said clauses with the text of other claims in said corpus to generate scores indicative of which clauses within said claim text have a lower probability of being found in other claims within said corpus (col.19, lines 35-45).

As to claim 5, Barney discloses the claimed displaying said patent information in a sorted order based on said claim breadth metric (items 740 and 720 of fig.11).

As to claim 6, Barney discloses the claimed wherein said step of analyzing the claim text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus (col.25, lines 13-23).

As to claim 7, Barney discloses the claimed displaying said claim text such that said one clause is visually presented differently than the other of said clauses (see fig.11).

As to claims 8 and 10, Barney discloses the claimed retrieving a corpus of patent information from a database (col.11, lines 44-65; col.24, lines 14-18); analyzing said patent information to generate a category metric "(col.24, lines 14-35); associating said category metric with said patent information and storing said associated metric in a computer-readable dataset (col.26, lines 1-56).

As to claim 9, Barney discloses the claimed wherein said patent information includes patent classification information and wherein said analyzing step is performed by defining a plurality of categories and mapping classification information onto said categories (col.26, lines 1-15; col.28, lines 13-25).

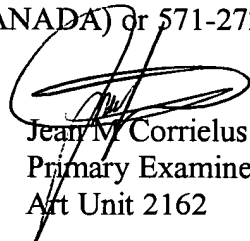
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jean M. Corrielus
Primary Examiner
Art Unit 2162

June 8, 2006